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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,066	03/12/2001	Michael Safdeye	0851/01118	7498

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,066

Applicant(s)

SAFDEYE ET AL.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 27-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5610.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status of Previous Office Action

1. The Office Action dated April 17, 2002 has been withdrawn due to the crossing in the mail of an amendment to the claims prior to an Office action on the merits of the claims. Since claims 27-38 were not addressed in the previous Office action, an examination on the merits of these claims as well as those elected in Paper No. 8 follows.

Election/Restrictions

1. Claims 18-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8. The restriction is thereby made **final** and any response to the Office action must include cancellation of the non-elected claims.

Specification

2. The disclosure is objected to because of the following informalities: reference number 42 was defined as "outer surface" on page 9, lines 7-8 then later referred to as "backing layer" on page 9, line 13, page 12, line 2 and page 12, line 19; reference number 204 was defined as "second die" on page 16, line 5 then later referred to as "second mold" on page 16, line 12. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the term "a lower" in line 3 of the claim which renders the claim vague and indefinite. Since this term is not known in the art and the only definition of a lower in the specification is that which is below the upper, it is unclear as to what portion of the shoe is meant to be encompassed by the term "a lower". Is the lower a lower portion of the upper? Is the lower a sole portion for the upper? Claims 12, 13 and 17 contain limitations that are improper in a claim. Claims 12, 13 and 17 attempt to limit the invention based on a classification under the Harmonized Tariff Schedule of the United States. Since this information fails to structurally further limit the claim, it is improper to place this information within the body of the claim. The Harmonized Tariff Schedule is subject to change and therefore does not effectively structurally define a ground-contacting surface. Claim 15 contains the limitation that the "first section includes a backing layer formed of a non-fabric material and being connected to the fabric material to define an integral assembly, wherein the fabric material is free of contact with the section.". Firstly, it is not clear how the fabric material can be attached to the first section including a backing layer and then also not be attached to the section. Since the backing layer is said to be part of the section and the fabric material is attached to the backing layer, it would follow that the fabric layer is attached to the section. Secondly, it is unclear as to which section the applicant is referring to, the first or second section.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-6 and 8-17, 27-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters 384,483. Walters '483 discloses all the limitations of the claims including the following: an upper (see Figures 1 and 2); a lower (insole a) attached to the upper; an outsole (B) attached to the lower; the outsole (B) having a ground contacting surface (see Figure 3) made of first (b and b¹) and second (b² and b³) sections; the first section being formed of a first material (rubber); the second section having an outer layer (D and C) formed of a fabric material; the first section is free of fabric material; the fabric material is free of contact with the first section (first section surrounds the fabric material but is not attached thereto); the second section includes a backing layer (see Figure 7, in this embodiment, the backing layer is part of the outsole. Alternatively, if a through hole were made in the sole, the backing layer would be the insole. See col. 2, lines 62-72) formed of a second material; the fabric material of the outer layer is connected to the backing layer defining an integral assembly (see Figures); only the backing layer of the integral assembly contacts the first material (in the instance where the backing layer is part of the insole this is true); backing layer connected to the first material (insole connected to outsole); backing layer and first material made of same material (backing layer and first material can be outsole where cavities, rather than through holes, are made in the outsole.); a gap located between the fabric and first material (Figure 3, first material b does not cover C or D); the first material is rubber (rubber strips); the bottommost section of the fabric material and the bottommost section of the first section are planar with respect to one another (see col. 2, lines 77-80); the fabric material bulges outwardly from the surrounding portions so that the fabric material extends beyond a plane containing the ground contacting surface of the surrounding portions (see col. 2, lines 80-83). With respect to claims 12, 13 and 17, the sole is covered more than 50% by the fabric (see Figures 3 and 7). With respect to claim 9, since a thermoplastic material is a polymer that is melted to process,

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rubber meets this limitation and therefore the rubber of the Walter s '483 reference meets this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters 384,483 as applied to claim 1 above in view of Mitchell 1,716,790. Walters '483 as applied to claim 1 above discloses all the limitations of the claim except for the fabric material being a non-woven fabric material. Mitchell '790 teaches that a non-slip material made of felt, known to be a non-woven material, can be placed on the bottom of a shoe's sole to aid in preventing the shoe from slipping on surfaces during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use felt pads, as taught by Mitchell '790, as the cloth sole strips of Walters '483 as applied to claim 1 above, to aid in preventing the sole of the shoe from slipping on contact surfaces.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

10. Applicant's filing of an affidavit under 37 CFR 1.131 is considered moot with respect to the references used in the rejections above.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

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Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
May 3, 2002